

ESTTA Tracking number: **ESTTA217826**

Filing date: **06/13/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	OliverMcMillan Corporation
Granted to Date of previous extension	06/18/2008
Address	733 8th Avenue San Diego, CA 92101 UNITED STATES
Attorney information	Kiley B. MacDonald, Esq. The Trademark Group, APLC 1200 Prospect Street, Suite G-100 La Jolla, CA 92037 UNITED STATES usdocketing@trademarkgroup.com Phone:8584564801

### Applicant Information

Application No	77154458	Publication date	02/19/2008
Opposition Filing Date	06/13/2008	Opposition Period Ends	06/18/2008
Applicant	STARWOOD HOTELS & RESORTS WORLDWIDE, INC. 1111 WESTCHESTER AVENUE WHITE PLAINS, NY 10604 UNITED STATES		

### Goods/Services Affected by Opposition

Class 037. All goods and services in the class are opposed, namely: REAL ESTATE DEVELOPMENT
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### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77187626	Application Date	05/22/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ALOFT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2003/10/11 First Use In Commerce: 2003/10/11 leasing of real property, real estate investment, real estate management Class 037. First use: First Use: 2003/10/11 First Use In Commerce: 2003/10/11 real estate development; improvement and construction of residential and/or commercial real property

Related Proceedings	91176766, 91177273, 91180734, 91180113, 91182167, 91184444, 91184570
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Attachments	77187626#TMSN.jpeg ( 1 page )( bytes ) ALOFT - ALOFT and Design Class 37 - 6-13-2008 - Notice of Opposition.pdf ( 4 pages )(149694 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/KABM/
Name	Kiley B. MacDonald, Esq.
Date	06/13/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**OliverMcMillan Corporation**

v.

**Starwood Hotels & Resorts Worldwide, Inc.**

Box TTAB

FEE

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

) Opposition No. \_\_\_\_\_  
)  
) In the matter of Application  
) Serial No. 77/154,458  
) Mark: **ALOFT and Design**  
) Published in the *Official Gazette* on  
) February 19, 2008.  
)

NOTICE OF OPPOSITION

Opposer, OliverMcMillan Corporation, organized under the laws of California, located and doing business at 733 8<sup>th</sup> Avenue, San Diego, California, 92101, believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes same.

Applicant's application for **ALOFT and Design** was filed on April 11, 2007 for real estate development in International Class 37. It was published for Opposition in the *Official Gazette* on February 19, 2008. Opposer has, therefore, until Wednesday, June 18, 2008 to file this Notice of Opposition and has filed it timely on or before June 18, 2008.

## STANDING AND GROUNDS FOR OPPOSITION

1. Opposer is the owner of the common law trademark **ALOFT** which has been popular and well known in various metropolitan regions of the country for almost six years since its first use as early as 2003. Opposer's services rendered in connection with the trademark **ALOFT** have been advertised throughout these regions and others of the U.S. resulting in strong consumer recognition. The mark, therefore, is entitled to strong protection under trademark law.

2. Opposer is the owner of a pending trademark application for the word mark **ALOFT**, Serial No. 77/187,626 in the United States. This application covers leasing of real property, real estate investment, real estate management in International Class 36 and real estate development; improvement and construction of residential and/or commercial real property in International Class 37.

3. Said mark of Opposer is symbolic of extensive good will and consumer recognition built through substantial effort and expense in advertising and promotion for nearly a six year period. The trademark has acquired recognition in various metropolitan cities within the United States. Opposer's trademark forms the basis for a vast real estate venture including real estate development, real estate investment and management, leasing of real property, and improvement and construction of residential and/or commercial real property. Under this program, Opposer's trademark has been widely and extensively used. Registration of Applicant's alleged mark would deprive Opposer of the exclusive use of its trademark, would infringe said trademark, would violate Opposer's rights therein, would expose Opposer to further violation of its trademark by others, and would diminish the commercial value of the trademark to Opposer in various ways. In addition, such registration would be a source of damage and injury to Opposer's potential developments, licensees and customers.

4. Opposer has clear priority of use. Opposer, since as early as 2003, has been, and is now, using the mark **ALOFT** in connection with the leasing of real property, real estate investment, real estate management in International Class 36 and real estate development;

improvement and construction of residential and/or commercial real property in International Class 37. Said use has been valid and continuous since said date of first use and has not been abandoned.

5. The alleged mark **ALOFT and Design** intended to be registered by the Applicant is confusingly similar to Opposer's mark. Consumers are highly likely to be confused into thinking this alleged mark is related to Opposer. They are even more likely to be confused because Applicant's alleged mark and Opposer's mark are for use on identical services. Opposer's mark has been in use in connection with various and substantial real estate services, including real estate development, such that consumers have come to know and recognize Opposer's mark. Applicant proposes to offer real estate development under its alleged mark. Use and registration of Applicant's alleged mark **ALOFT and Design** will cause confusion, mistake or deception. The public is likely to be deceived as to the source of Applicant's services and/or falsely infer a connection with or endorsement by Opposer. In view of the identity of the literal terms of the respective marks and the identical nature of the services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

6. Consequently, Applicant's alleged mark does not and cannot exclusively identify the services on which it is used as the services of the Applicant, nor can it serve as an indication of the source of origin of such services. Therefore, Applicant should not be entitled to registration of its alleged mark.

7. On information and belief Applicant's alleged mark **ALOFT and Design** was adopted in bad faith with knowledge of Opposer's prior and superior rights in the mark **ALOFT**. On information and belief Applicant knew it was not entitled to the mark for which it seeks registration, but nevertheless swore that Applicant was entitled to use the mark and that no one else had the right to use the same or similar mark in commerce. Therefore, Applicant should not be entitled to registration of its alleged mark.

8. Opposer has had common law rights for almost six years. Opposer has spent considerable time and effort and invested thousands of dollars in the development of good will and expansion of its **ALOFT** projects and organization of a strategic planning program to develop other **ALOFT** projects. On information and belief Applicant has no more than an "intention" to use the confusingly similar mark. Therefore, Applicant should choose a new mark, one which is not confusingly similar and one that is not an unfair attempt to take advantage of Opposer's years of effort and financial investment.

9. Opposer hereby gives notice under 37 C.F.R. 2.122 that at any hearing and on any appeal of this opposition proceeding it will rely on any existing trademark and copyright registrations, common law trademark rights, and pending trademark applications.

WHEREFORE, OliverMcMillan Corporation prays that this opposition be sustained in favor of Opposer, that application Serial No. 77/154,458 be rejected, and that no registration be issued thereon to Applicant.